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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
07/715.258	06/14/91	WILLIAMS	J DS/91068
			EXAMINER

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NM11/0218

TUNG M	ART UNIT	PAPER NUMBER
2911		15

DATE MAILED: 02/18/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☒ Responsive to communication(s) filed on November 7, 1997
- ☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) _____ is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) is finally _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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1. Applicants' amendment submitted November 7, 1997 is acknowledged.
2. The claim is again and **FINALLY REJECTED** under 35 U.S.C. 112, first paragraph for new matter. The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under 35 U.S.C. 112, first paragraph should be withdrawn.
3. Applicants first assert that a broken line disclosure has basis in the title, specification and claim. In support of this assertion, applicants refer to the prior art submitted concurrently with the original application papers, the results of a Lexis® database search, dictionary definitions of "computer" and "display" and classification of the instant application in D18, "printing and office machinery." While applicants' references and evidence are acknowledged, they do not address the new matter issue. The relationship between an "icon" and a "computer display" is not in question. The examiner concedes that computer generated icons are generally understood to be displayed on some type of electronic screen. However, the issue is whether or not there is support in the original title, specification, and drawing to support the specific configuration of the broken line disclosure in the amendment submitted May 24, 1993.
4. Applicants assert that a "computer display" is understood by both skilled and laypersons (dictionary definitions submitted as evidence) to be an article for displaying information. Although this argument is acknowledged, the literal definition of "computer display" is not at issue in this rejection. The essence of a design claim is what is shown in the drawing. Merely understanding the meaning of a word does not necessarily describe its visual characteristics.

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5. For example, hypothetically, if the word "automobile" appeared in a specification, but no drawing of a specific automobile appeared in the original drawing, it would be nearly impossible to argue that any type of automobile could be shown in subsequent drawings without introducing new matter in a design patent sense. Would the automobile be a compact car, a recreational vehicle, a convertible sports car or a full-sized luxury car? In addition to the endless possibility of different models is the possibility of a variety of details which may make designs of a similar models patentably distinct. Jumping from a one word description, "automobile," to a detailed broken line disclosure of a 1972 Volkswagen Beetle is akin to jumping from "computer display" to the broken line disclosure added by amendment. The addition of elements to the drawing disclosure, when there is no support nor suggestion for it, violates the patent statute.

6. Applicants next assert that in view of the patent literature available at the time the instant application was filed, one skilled in the art would understand that an icon is embodied in a computer display. Again, whether an icon conceivably is embodied on a computer display is not at issue. The issue is whether there is actual basis in the original drawing and specification to support the specific broken line disclosure added in the subsequent amendment. The words, "computer display," are not sufficient to support the specific broken line disclosure because an icon which is embodied on a display or computer screen can be shown in a variety of ways. Since the essence of the claim is in the design patent drawing, specificity of the design patent drawing is critical. An icon can be shown in a bottom corner of a small screen, a top corner of a large

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rectangular screen, the middle of a square screen, etc.... The configuration must be definite to meet the requirements of 35 U.S.C. 112.

7. The computer display is not a "conventional feature," as asserted by applicants, in the design sense. Applicants must remember that the scrutiny under which a design drawing and specification undergoes is quite different than in a utility application. Since the drawing essentially is the claim, details cannot be added, changed or deleted with as much liberty as in a utility application. Changing the drawing is the same as changing the claim.

8. The examiner disputes that there is "reasonable support" for the addition of the broken line disclosure (and it's corresponding special description). Clearly, the computer display was not disclosed in the original drawing, and no description existed in the original specification to clearly define the characteristics of the subsequently added broken line drawing. The words in the title, alone, are insufficient support.

9. Applicants' attempt to overcome the new matter rejection by disclaiming any proportional relationship between the icon and the screen is also insufficient. In fact, since the special description is so vague with the addition of the disclaimer, it likely elicits additional problems under 35 U.S.C. 112. Broken line disclosure is essentially a "disclaimer" since it is not claimed subject matter, and applicants appear to be disclaiming the disclaimer.

10. Applicants erroneously assert that the examiner is giving undue weight to the broken line disclosure. Although broken line disclosure exists to illustrate environment or the underlying article of manufacture, it cannot be treated as irrelevant nor insignificant. In this very situation,

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the broken line disclosure will determine whether the computer-generated icon qualifies as statutory subject matter under 35 U.S.C. 171. The Guidelines have established that a broken line disclosure is required to properly disclose a computer-generated icon as statutory subject matter under 35 U.S.C. 171. Broken line disclosures, on the contrary, are significant. What applicants propose is the addition of a broken line disclosure of a computer display, a display that was not shown in the original drawing nor specifically described in the original specification.

11. Applicants cite In re Zahn, 204 U.S.P.Q. 988 (CCPA 1980) to support the notion that the broken line drawing is only meant for environmental or background purposes, and therefore need not be specific. The decision in Zahn, however, does not argue against the new matter rejection set forth in this application. The issue decided in Zahn was that a design for a portion of an article could be claimed subject matter, and that a unitary, complete article was not necessary under 171. The specific cite on p.8 of Applicants' response is part of the Court's reasoning that if the inventor wanted to claim a design for a portion of an article, there was no prohibition against so doing. Broken line disclosure in that case was used to show the remainder of the unitary article. How Applicants apply Zahn to support withdrawal of the new matter rejection is not clear because the Court did not specifically speak to the addition of broken line disclosure.

12. The addition of the broken line drawing and the special description clearly violates 35 U.S.C. 112, first paragraph. There is no computer display screen shown in the original drawing.

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The specification and title are not specific enough to describe the particular computer display shown in the amended drawings submitted May 24, 1993.

13. In an attempt to overcome this rejection, applicants must cancel the broken line illustration and the added special description. Note, however, the outstanding rejection of the claim under 35 U.S.C. 171. Applicants are advised that the claim might be fatally defective; that is, it might not be possible to meet the requirements of the Guidelines without introducing new matter.

14. The claim is again and **FINALLY REJECTED** under 35 U.S.C. 171 as being directed to nonstatutory subject matter. The arguments presented have been carefully considered, but are not persuasive that the rejection of the claim under 35 U.S.C. 171 should be withdrawn.

15. Although the addition of the broken line disclosure is an attempt to meet the requirements of the Guidelines, the examiner considers the addition improper under 35 U.S.C. 112. Since it is the examiner's position that the addition of a broken line drawing violates 35 U.S.C. 112, first paragraph, and overcoming the 112 rejection requires removal of the broken line disclosure, the rejection under 35 U.S.C. 171 is maintained. Had the original drawing and specification offered support for the broken line disclosure, the rejection of the claim under 171 would not be proper.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

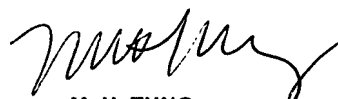
A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NO MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE

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SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Tung, whose telephone number is (703)305-3105. The examiner normally can be reached Monday-Thursday from 7:30 to 6:00. The FAX phone number for this group is (703)308-2742. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)-305-3293.

mht
February 12, 1998


M. H. TUNG
PRIMARY EXAMINER
ART UNIT 2901